

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 19, 33, 34 and 35 have been amended. No new matter had been submitted.

It is noted that claim 22 has been indicated as rejected on the Office Action Summary, but no rejection of the claim has been presented in the body of the rejection.

Claims 18-22 and 24-35 are pending and under consideration.

REQUEST FOR NEW OFFICE ACTION AND ENTRY OF AFTER FINAL AMENDMENT

Entry of this After Final Amendment is respectfully requested, at least as it places the application in allowable form and because the outstanding Office Action would appear to be improper.

Differences between the amended claims and the purported combinations is respectfully set forth below. But first, it is noted that the outstanding Office Action would appear to have failed to comment on applicant's previous comments and detailed remarks regarding the proffered combination of references.

While the outstanding Office Action has responded to the applicants' previous comments by indicating that the underlying combinations are proper because they are in related fields, the Office Action has failed to address applicants' detailed discussion against the combining of references proffered in the Office Action. See page 2 of the Office Action which states that the Examiner disagrees with applicants arguments that the problems/solutions in Hayashi et al., U.S. Patent No. 6,069,884, and Jolma et al., U.S. Patent No. 5,806,003, are not identical or applicable to each other, by stating that the combinations are proper since both references are directed in the same field, i.e., two way communication, for example.

Specifically, it was pointed out that Jolma et al. pertains to a GSM system, while Hayashi et al. pertains to a CDMA system, and that Hayashi et al. deals with the sending of signals via the plurality of antennas and receiving and handling the signals at the mobile.

It was further pointed out that the emphasis in Jolma et al. is on a signal being sent from a mobile to the base station, namely on the Channel Request Message of the mobile (and thereafter on a message from the mobile to the base station about the power level used by the

mobile for transmitting the channel request, see claim 1 in Jolma et al.)

Conversely, it was pointed out that Hayashi et al. is directed toward signals being sent from the base station to the mobile. Essentially, Jolma et al. is directed toward the "uplink" while Hayashi et al. is directed toward the "downlink."

Thus, it was particularly pointed out that the underlying premises and/or solutions each reference was directed toward were dealing with fundamentally different aspects of mobile communication, i.e., while a solution directed toward a downlink may not be applicable to an uplink.

In addition, since the underlying primary reference is directed toward one aspect, i.e., the uplink, it is not automatically obvious to completely change that primary direction. As detailed in the MPEP, where one reference is directed in one direction, and a suggested modification of the same would change the direction of the primary reference, the motivation to still make such a combination is quite lessened. Similarly, here with Jolma et al. being directed to the uplink, and all the associated problems thereof, it would not have been obvious to radically change Jolma et al., as suggested in the Office Action.

Further, in another point against the Office Action suggested modification of Jolma et al., Jolma et al. details the process of a call establishment, while Hayashi et al. pertains to signals in the course of a communication between a mobile and a base station.

This is further evidence against obviousness, and was particularly pointed out in the last response.

Thus, the Examiner's comments presented in the outstanding Office Action, i.e., that the obviousness arguments are proper since both references deal with two-way communication and because both references are wireless data signal connection oriented, does not refute or counter the detailed non-obviousness evidence presented in the last response.

Further, it was pointed out in the last response that some rejections merely recited what features could be found in secondary references, as support for disclosing claimed features in a proffered combination. However, features in the secondary references do not automatically transfer with the proffered combination merely because a feature from that secondary reference was also combined with a primary reference. Each proffered feature from secondary references must be supported by a *prima facie* obviousness case for that feature to be combined with the already modified primary reference. For example see the present rejections of claims 24 and

28-29.

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

As such, since the Examiner has not addressed the applicant's traversals presented in the last response, it is respectfully requested that the Examiner withdraw the Final Office Action and issue a new Office Action addressing the same. In addition, at least in view of the new amendments to the claims, it is respectfully submitted that the claims are further differentiated from the cited prior art.

REJECTION UNDER 35 USC 103

Claims 18-20, 24-29, 31-34 stand rejected under 35 USC 103(a) as being obvious over Jolma et al., in view of Gardner et al., U.S. Patent No. 5,729,557, and Hayashi et al. Claim 21 stands rejected under 35 USC 103(a) as being obvious over Jolma et al., Gardner et al., and Hayashi et al., in view of Gilhousen et al., U.S. Patent No. 5,485,486. Claim 30 stands rejected under 35 USC 103(a) as being obvious over Jolma et al., Gardner et al., and Hayashi et al., in further view of Bender et al., U.S. Patent No. 6,366,779. These rejections are respectfully traversed.

In addition to the above remarks, the following comments are also presented.

The independent claims have been amended to include the features that if the access radio block, sent to the base station, has not been successfully detected by the base station, a new access radio block is sent by the mobile station with increased power. An example of this feature can be found discussed in the filed specification on page 6, line 7, through page 7, line 5.

It is respectfully submitted that the proffered combinations of references at least fail to disclose this feature. For example, Jolma et al. fails to address the problem of the base station not having received the signal sent by the mobile station. In fact, in Jolma et al., the calculation of the mobiles transmission power (col. 4, lines 33-39) aims at providing for the base station being able to successfully detect the mobiles signal for sure. Thus, the aforementioned new feature amounts to a solution of a problem neither disclosed or suggested by Jolma et al. Further, none of the other references, alone, or in combination, provide such suggestion or disclosure.

Therefore, for at least the above, it is respectfully requested that this rejection be withdrawn and these claims allowed.

Briefly, the following is noted, in the rejections where the Office Action indicates that certain features are inherent, applicant respectfully notes that such citations fail to support a *prima facie* obviousness case.

"[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the 'page and line' of the prior art which justifies an inherency theory." Ex parte Schriker, 56 USPQ2d 1723 (BdPatApp&Int 2000).

For example, on page 6 of the Office Action, the Office Action indicates that since "the modified Jolman et al. do not mention about the access radio block is spread. Therefore, it is inherently that the access radio block is not spread." This conclusion lacks support, since merely because a reference does not indicate "something"; doesn't mean that "something" isn't actually there. Further, such an inherency argument must be supported by page and line numbers, i.e., col. and line numbers.

Further, where the Office Action has taken Official Notice, applicants respectfully request that the a reference be provided supporting such a conclusion and that proper motivation be provided to support the conclusion that such a feature would be an obvious modification of the underlying primary reference.

While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when

such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

Further, the applicant should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion.

However, using the rejection of claims 26-27 as an example, the Office Action would appear to be relying on a broad concept that "partially and/or complete compensation are well known in the art," to support the obviousness rationale of modifying the underlying primary reference. This would appear to be contrary to the aforementioned guidelines, since such concepts are not instantly and unquestionably demonstrated and do more than just fill in the gaps. Further, as pointed out previously, Jolma et al. would only appear directed toward complete compensation, and it would appear contrary to purposely have less than full compensation when full compensation is available. So, it would not appear obvious to modify Jolma et al. to have this feature.

In summary, reconsideration of the allowability of the claims is respectfully requested. It is respectfully submitted that the pending claims are in proper condition for allowance and patentably distinct over the cited prior art.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

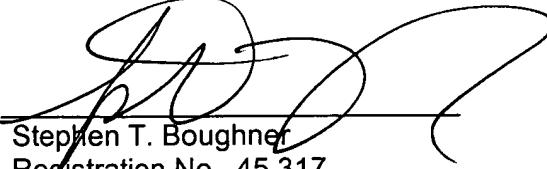
If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 3/11/04

By:


Stephen T. Boughner
Registration No. 45,317

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501